

REMARKS

The following issues are outstanding in the present application:

- Claims 22-23, 25-28 and 32-38 have been rejected under 35 U.S.C. 102(b); and
- Claims 22-38 have been rejected under 35 U.S.C. 103(a).

Claim Amendments

Claims 22 and 23 have been amended in order to more distinctly claim the subject matter of the present invention. Independent claim 22 has been amended to recite “cutting the plurality of labels on the web to form a plurality of cut labels having a preselected size and shape” and dependent claim 23 has been amended in order to conform the text with amended claim 22. No new matter has been added.

35 U.S.C. 102(b)

Claims 22-23, 25-28 and 32-38 have been rejected under 35 U.S.C. 102(b) as having subject matter anticipated by U.S. Patent No. 5,582,433 to Sisson. Applicant respectfully traverses this rejection.

Sisson is directed to garage sale pricing labels that include rolls of label sets or folded, flat strips of labels that are packaged side by side. The labels are described as being stock tape roll stickers formed on transversely perforated strips in which the perforations facilitate removal of each sticker from the strip (Col. 3, lines 49-51, lines 63-65; Col. 4, lines 20-22). The Sisson reference states that non-perforated tape may be used, however, there is no teaching or suggestion as to the shape of the stickers on the non-perforated tape, how they would be formed or how they would be removed. The shape and size of the Sisson labels is determined by the width of the tape roll stickers or the printable flat back paper tape used to form the garage sale labels and the distance between the perforations on the tape (Col. 4, lines 20-22, lines 30-31).

For a prior art reference to anticipate, “every element of the claimed invention must be identically shown in a single reference.” *In re Bond*, 910 F.2d 831 (Fed. Cir 1990). Further, “to anticipate a claim, a reference must disclose every element of the challenged claim and enable one of ordinary skill in the art to make the anticipating subject matter.”

PPG Indus., Inc. v. Guardian Indus. Corp., 37 U.S.P.Q.2d 1618 (Fed.Cir. 1996). Applicant respectfully submits that nowhere does the Sisson reference teach or disclose a plurality of cut labels having a preselected size and shape. The labels of the Sisson reference are not cut from a web to form a preselected size and shape of label. Instead, the size and shape of the Sisson label is determined solely by the width of the tape used to form the pricing labels and the distance between the perforations on the tape. Further, there is no teaching or disclosure as to any other label shape possible other than a rectangle or square shape. Therefore, Applicant respectfully submits that since Sisson fails to teach or suggest each and every limitation of amended independent claim 22, a rejection under 35 U.S.C. 102(b) cannot be sustained. Since claims 23, 25-28 and 32-38 depend at least in part from independent claim 22, they are also by definition not anticipated by the Sisson reference. Accordingly, Applicant respectfully submits reconsideration and withdrawal of the outstanding rejection of claims 22-23, 25-28 and 32-38 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,582,433 to Sisson.

35 U.S.C. 103(a)

Claims 22-38 have been rejected under 35 U.S.C. 103(a) as having subject matter unpatentable over Sisson. Applicant respectfully traverses this rejection.

The Examiner has stated that Sisson fails to teach that the labels are circular in shape, but that it would have been an obvious matter of design choice to modify Sisson to have circular-shaped labels. To establish a *prima facie* case of obviousness, the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The claims of the subject invention are directed to labels cut from a web which forms a plurality of cut labels having a preselected size and shape. There is nothing in Sisson that teaches or suggests a plurality of cut labels having a preselected size and shape. The labels of the Sisson reference are not cut from a web to form a preselected size and shape of label. Instead, the shape and size of the Sisson labels is determined solely by the width of the tape roll stickers or the printable flat back paper tape used to form the labels and the distance between the perforations on the tape. The labels of the Sisson reference will always be rectangular or square in shape as determined by the stock paper tape used to form the Sisson labels and the distance between the perforations on the tape. The Sisson reference also describes labels in which only one label is placed horizontally across the width of the tape. This is because the labels are formed from tape roll stickers or the printable flat back paper

tape in which the width of the tape is the width of each individual label. In fact, forming the Sisson labels by cutting the labels from a web to form a preselected size and shape of label would defeat one of the main problems solved by the Sisson labels, which is providing inexpensive (Col. 1, line 6; col. 3, line 48; Col. 4, line 22-23), easily manufactured (Col. 4, line 67, Col. 5, line 1-3) labels. Accordingly, Applicant respectfully submits reconsideration and withdrawal of the outstanding rejection of claims 22-38 under 35 U.S.C. 103(a) as being unpatentable over Sisson.

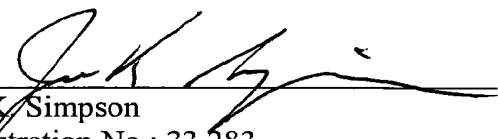
CONCLUSION

In view of the above, Applicant respectfully submits that each of the presently pending claims in this application is believed to be in condition for allowance. According, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. 10103588 from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: 6-6-03

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